

Remarks/Arguments

Applicants have received and carefully reviewed the Final Office Action of the Examiner mailed August 22, 2008. Claims 1, 16 and 31 have been amended. Currently, claims 1-44 remain pending. Favorable consideration of the following remarks is respectfully requested. This paper is being filed with a Request for Continued Examination.

Claim Rejections – 35 USC § 103

Claims 1, 8-10, and 12-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Chien et al.* (U.S. Patent No. 6,165,163), in view of *Sarge et al.* (U.S. Patent No. 6,508,804).

“All words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). (MPEP § 2143.03). Nowhere does *Chien et al.* appear to disclose a “coil assembly [[is]] disposed about at least a portion of the distal end of the shaft”. However, in order to move prosecution along in this case, Applicants have amended independent claim 1. Claim 1 now recites an embolic protection sheath comprising a coil assembly having a diameter that is larger than the diameter of the shaft; and wherein the coil assembly is attached to the outer surface of the distal end of the shaft. The *Chien et al.* reference does not appear to disclose these limitations. Furthermore, *Sarge et al.* does not overcome these deficiencies. For this reason, Applicants believe claims 1 is in condition for allowance and respectfully request that the rejection of independent claim 1 be withdrawn. Accordingly, since claims 2-15 are dependant on claim 1, Applicants respectfully request that the rejections of claims 2-15 be withdrawn as well.

Claims 2-7 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Chien et al.* (U.S. Patent No. 6,165,163) in view of *Sarge et al.* (U.S. Patent No. 6,508,804) and further in view of *De Mello et al.* (U.S. Patent No. 5,429,597). After careful review, Applicants must respectfully traverse this rejection. For reasons similar to those stated hereabove, Applicants believe claims 2-7 are non-obvious and patentable over the cited art.

The Examiner rejected claim 11 under 35 U.S.C. 103(a) as being unpatentable over *Chien et al.* (U.S. Patent No. 6,165,163) in view of *Sarge et al.* (U.S. Patent No. 6,508,804) and further in view of *Samson et al.* (U.S. Patent No. 6,143,013). After

careful review, Applicants must respectfully traverse this rejection. For reasons similar to those stated above, Applicants believe claim 11 is patentable over the cited references.

Claims 16, 23-25, 27-31, 38-40, and 42-44 were rejected under 35 U.S.C. 103(a) as being unpatentable over *Ginsburg* (U.S. Patent No. 4,873,978), in view of *Chien et al.* (U.S. Patent No. 6,165,163) and *Sarge et al.* (U.S. Patent No. 6,508,804). To advance prosecution in this case, Applicants has amended independent claims 16 and 31 to include further limitations. Claims 16 and 31 now recite an embolic protection sheath having a diameter that is larger then the diameter of the shaft; and wherein the coil assembly is attached to the outer surface of the distal end of the shaft. None of the cited references appear to disclose these features. For this reason, Applicants believe claims 16, 23-25, 27-31, 38-40, and 42-44 are non-obvious and patentable over the cited art.

The Examiner rejected claims 17-22 and 32-37 under 35 U.S.C. 103(a) as being unpatentable over the combination of *Ginsburg* (U.S. Patent No. 4,873,978) and *Chien et al.* (U.S. Patent No. 6,165,163)/*Sarge et al.* (U.S. Patent No. 6,508,804), and in view of *DeMello et al.* (U.S. Patent No. 5,429,597). For reasons similar to those stated above, Applicants believe claims 17-22 and 32-37 are patentable over the cited references.

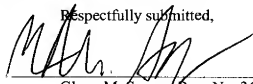
Finally, claims 26 and 41 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of *Ginsburg* (U.S. Patent No. 4,873,978) and *Chien et al.* (U.S. Patent No. 6,165,163)/*Sarge et al.* (U.S. Patent No. 6,508,804) in view of *Samson et al.* (U.S. Patent No. 6,143,013). For reasons similar to those stated hereabove, Applicants believe claims 26 and 41 are non-obvious and patentable over the cited art.

In view of the foregoing, all pending claims are believed to be in a condition for allowance. Reexamination and reconsideration are respectfully requested. Issuance of a Notice of Allowance in due course is anticipated. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Date:

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